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Supreme Court of the United States

October Term 1977

No. 77-1837

AVANT INCORPORATED,

Petitioner,

v.

POLAROID CORPORATION,

Respondent.

BRIEF OF POLAROID CORPORATION IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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BRIEF OF POLAROID CORPORATION IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

There is nothing about this ordinary patent case which warrants a review by this Court on the merits.

The decision of the Court of Appeals for the First Circuit, holding petitioner's patent invalid, is manifestly correct. There is no conflict between decisions of Courts of Appeals on the same matter. No question of public importance is involved. There has been no departure from the accepted and usual course of judicial proceedings. In short, there is no special or important reason why the writ prayed for should be granted.

QUESTIONS PRESENTED

The fundamental question is whether a District Court may properly hold invalid for obviousness, under 35 U.S.C. Sec. 103, a patented method for laminating a data card which comprises (i) providing an envelope, all features of which were known and used in the prior art, and (ii) taking advantage of these features, in a natural and unsurprising way and in a manner plainly taught by the prior art.

Petitioner Avant Incorporated ("Avant") raises eleven subsidiary questions which can be succinctly encapsulated in two questions:

(1) Whether the findings of fact, which predicate the unanimous decisions of the United States Court of Appeals for the First Circuit and the decision of the District Court of Massachusetts invalidating the patent in issue, should be reexamined by this Court when those findings are amply supported by evidence, were found pursuant to, and are embodied in decisions which accord with, decisions of this Court, decisions of other courts of appeals, and are not urged by Avant, by citation of any authority, to be in any way at odds with settled law; and,

(2) Whether the District Court, in allowing Avant to offer into evidence whatever timely-presented proof it wished, departed from the accepted and usual course of judicial proceedings and violated the requirements of due process by (i) rejecting certain evidence after Avant waived its right to introduce such evidence, (ii) relying on the correctness of Hazeltine Research, Inc. v. Brenner, 382 U.S. 252 (1965), or (iii) in issues raised for the first time in this Court, limiting trial of the validity of a simple patent to two days, rendering its decision a year after trial, or indicating during trial that the evidence earlier presented pointed to the invalidity of the patent in issue.

STATEMENT OF THE CASE

Avant is the assignee of United States Patent 3,679,512 (the "'512 patent"), allegedly conceived and reduced to practice in June 1966. The patent was issued on July 25, 1972, and Avant filed

its infringement action on December 27, 1972. Polaroid answered and counterclaimed for a declaratory judgment of invalidity of the '512 patent. Polaroid's invalidity defenses and counterclaim were based upon: (1) 35 U.S.C. Sec. 102 because of anticipation, prior public use, prior knowledge, and prior public sale; (2) 35 U.S.C. Sec. 103 because of the obviousness of the subject matter of the '512 patent to a skilled mechanic presumed to know the prior art; and (3) 35 U.S.C. Sec. 112 for failing distinctly to claim and adequately to describe the subject matter of the '512 patent.

On December 17, 1974, Polaroid filed a motion for summary judgment on its counterclaim of invalidity and the parties submitted extensive briefs, affidavits and numerous exhibits. The motion for summary judgment was denied without prejudice by the District Court, discovery was concluded and, with the concurrence of Avant, a trial on the issue of validity was scheduled and held on June 7 and 8, 1976.

Following the trial, at Avant's own suggestion, (Trial Transcript, Second Day, p. 100) the parties designated for the record hundreds of pages of deposition testimony, and submitted over a hundred pages of post-trial memoranda, proposed findings of fact and suggested conclusions of law.

The District Court rendered its opinion on June 8, 1977, holding the '512 patent invalid for obviousness under 35 U.S.C. Sec. 103. Avant Incorporated v. Polaroid Corporation, 441 F. Supp. 898

(D. Mass. 1977) (28a-48a).* Avant appealed to the United States Court of Appeals for the First Circuit some, but by no means all, of the issues presented by Avant in its Petition for Certiorari (several of which questions were not even raised in the District Court). After receiving the parties' briefs and hearing extended oral argument, on March 21, 1978, the First Circuit affirmed the opinion of the District Court in all respects. Avant Incorporated v. Polaroid Corporation, 572 F.2d 889 (1st Cir. 1978) (49a-54a).

The '512 patent** claims a method for laminating a data card insert (e.g., a driver's license) between a pair of outer transparent sheets. The art of laminating inserts between plastic sheets by heat or pressure is old. As taught in the prior art, it is conventional to place the insert between two plastic sheets which have an adhesive on their inner surfaces. When heat is to be employed to seal the envelope, the adhesive may consist of inner layers of plastic more heat responsive than the outer layers, so that when heat is applied by a device referred to generically as a "laminator," "bonder" or

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* Parallel cites to the decisions of the courts below refer to the appendix section of Avant's Petition and are designated by the appendix page number and the small letter "a".

** The '512 patent is annexed as an appendix to respondent's brief and is designated by the appendix page number and the small letter "r".

"press," the adhesive softens and binds together the heat resistant outer layers.

The '512 patent, entitled "Laminated Card Envelope," is admittedly simple. Although the laminating art has been much refined by development of new bonders and associated devices, research on different types and amounts of plastic and experimentation with the crucial operating variables of degree of heat and pressure, the '512 patent does not teach or claim any of those refinements. Rather, it simply claims a monopoly on a method of laminating an insert by starting with an envelope of two neatly aligned, equal size sheets (referred to, by implication in the '512 patent, 31r, as "congruent" sheets). The sheets are interconnected along one edge so that the opposing surfaces may be opened wide like a book ('512 patent, 31r). At its simplest, the envelope may be a single sheet of double layered plastic folded in half and reopened ('512 patent, 31r). A data card insert is inserted between the opposing sheets as a page of longhand notes might be inserted into a law book ('512 patent, 31r). The card is then pressed against the fold or interconnection (referred to as "coupling means"*) to facilitate registration

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* The "coupling means" of the envelope can have a number of configurations. As set forth in the "Specific Description" of the patent, such coupling means can

(footnote continued)

of the insert in a neat way ('512 patent, 31r). The sheets are then closed upon the insert, and heat is applied ('512 patent, 31r).

The evidence, findings and decisions below established that all elements of the method claimed in the '512 patent are present in the prior art. In a desperate effort to find something unobvious, Avant has increasingly relied upon the fact that the '512 patent claims "congruent" outer sheets, and that modern commercial systems which have attained a measure of success use neat, pre-sized envelopes. Avant then attempts to tie the modern commercial structure to the patented method by arguing (without evidentiary support) that since modern envelopes often do not "ooze" objectionable amounts of adhesive beyond their superimposed edges, the absence of "ooze" is attributable to "congruency," rather than to refinements in types and amounts of adhesive, the degree of heat and amount of pressure. Not only is there no evidence whatever in the record to support that contention, but it

(footnote cont'd from preceeding page)

simply be the fold of a sheet of material which has been folded in half. Alternatively, the coupling means include "nests" orthogonally positioned to each other as depicted in the patent drawing or a bar weld along one side of the envelope. Indeed, the coupling means could consist of adhesives such as pressure sensitive adhesives rather than simply a heat seal.

is dramatically refuted by the fact that Avant itself prosecuted a later-filed patent specifically directed toward minimization of "ooze" in which the crucial factor is proclaimed to be the amount of adhesive, United States Patent 3,679,514 (the "'514 patent").

The District Court, after trial in open court and after receiving extensive designations of deposition testimony and numerous exhibits and after petitioner Avant rested its case (without accepting the District Court's invitation to submit further evidence, Trial Transcript, Second Day, p. 182), adjudged the '512 patent invalid as obvious under 35 U.S.C. Sec 103. The District Court specifically found that all elements of the '512 patent were present in the prior art, 441 F. Supp. at 903, 906 (40a, 47a), that those asserted elements were not used in the subject matter of the '512 patent in any new or unusual way, ibid, and that "congruency" of the envelope was not a feature unique to the '512 patent but was present in the prior art, id. at 904 (41a-42a, 43a).

The United States Court of Appeals for the First Circuit affirmed, finding, as had the District Court, that the '512 patent was not precisely replicated in a single prior art patent but was clearly foreshadowed by the prior art, 572 F.2d at 890 (51a), that the patent contained no remarkable features and that a finding of obviousness was unavoidable, id. at 890 (52a). The Court of Appeals' opinion principally focused upon the assertions by Avant, argued at length at the appellate level, that the '512 patent

should be interpreted in a fashion strikingly different from the language of the claims. Id. at 891 (52a, 53a). As noted above, Avant pitched its argument upon the assertedly inevitable, but inexplicable, ramifications of "congruency" and ascribed to the '512 patent the advantage of eliminating the necessity for further trimming (as by "die-cutting") after lamination, notwithstanding Avant itself in prosecuting the '514 patent had stated that that advantage was first achieved by that later filed patent.

Respecting "congruency," the Court of Appeals noted the not surprising proposition that by starting with even edges one might be more likely to end up, after applying heat, with even edges. Id. at 891 (52a). Indeed, the court noted that no one would ever suggest any different proposition. Id. at 891 (53a). The Court of Appeals found, as did the District Court, that the congruent envelope of the '512 patent did in fact "ooze," absent the application of techniques not disclosed or claimed in the patent. Moreover, if the monopoly claimed in the '512 patent were deemed to be a heat-laminating technique which avoided post-lamination trimming by the simple expedient of beginning with neatly aligned edges, irrespective of heat, pressure or quantity of adhesive, the '512 patent, because of its failure to disclose such an invention or the important factors necessary to achieve that asserted result, id. at 891-92 (53a-54a), was additionally invalid under 35 U.S.C. Sec. 112, ibid.

The Court of Appeals also held that, pursuing the analysis suggested by

this Court in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), there was insufficient evidence of secondary indicia of nonobviousness to challenge the findings that the subject matter of the '512 patent, taken as a whole, was obvious to mechanics skilled in the art at the time of the "invention." Id. at 891 (54a).

In addition, the Court of Appeals specifically rejected Avant's assertion that evidence was improperly excluded and rejected generally Avant's challenges to the District Court's holdings. Id. at 892 (54a).*

REASONS FOR DENYING THE WRIT

The decisions of the courts below, in holding that the '512 patent is invalid for obviousness, are amply supported by evidence, are in full accord with the standards of patentability specified by Congress, this Court and the United States Constitution, and were rendered after careful consideration of the abundant evidence of obviousness presented in a procedurally fair manner.

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* Avant never raised before either court below many of the procedural challenges first made here -- that the two-day trial was too short, that the District Court took too long in rendering its opinion or that the District Court did not at all times give the appearance of impartiality.

None of the so-called questions presented by Avant is appropriate for review on Certiorari. Three of those questions (Nos. 1, 9 and 11) raise procedural matters -- primarily not raised in either court below -- whose prosaic character cannot be concealed by Avants reference to them as deprivations of due process. One of Avant's questions (No. 10) seeks to call in question -- apparently on constitutional grounds, although no serious constitutional argument was urged below -- a legal determination of both lower courts which was in specific accord with a dispositive ruling by this Court, repeatedly followed by the courts of appeals, without the citation of a single authority to support Avant's position. The balance of Avant's purported questions, when stripped of distortions and placed in context, constitute nothing more than a request to this Court to re-try the issues of patent invalidity and to upset the findings of fact and conclusions of obviousness which underlie the decisions of the District Court and the unanimous Court of Appeals panel.

ARGUMENT

POINT I

THE DECISIONS OF THE COURTS BELOW ARE AMPLY SUPPORTED BY EVIDENCE AND ARE IN ACCORD WITH SETTLED LAW.

The decisions below are amply supported by the evidence at trial, are in accord with settled law, and do not conflict with decisions in other courts of appeals. Despite all of the "Questions" raised by

petitioner Avant, Avant cites no case conflicting with any fair reading of the decisions below.

This Court has clearly delineated the tests for patentability under 35 U.S.C. Sec. 103 and the analytical inquiries appropriate for making that determination.

The basic obviousness test is set forth in 35 U.S.C. Sec. 103:

> A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains...

Resolution of the obviousness issue entails several basic factual inquiries enunciated in Graham v. John Deere Co., 383 U.S. 1, 17 (1966): "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

The District Court in the instant action carefully and meticulously made each of these inquiries: it analyzed the prior art, compared the prior art with the '512 patent, determined the skill in the art and found the '512 patent wanting. 441 F. Supp. at 901-05 (33a-46a).

Two items of prior art, in particular, were found to be pertinent in appraising the '512 patent in suit -- precut "platen half pouches" which were commercially available long before the purported '512 patent "invention," and United States Patent 3,505,180 (the "Dunn patent"). The precut platen half pouches were described by the District Court as an envelope of:

> essentially congruent plastic sheets which have been joined along one of four edges by heat seals. These outer sheets may, as in the case of the type of envelope taught by the '512 patent, be widely opened ('butterflied') so that an insert may be placed between them. Such an insert can be abutted against the seals for initial registration prior to lamination.

Id. at 904 (43a). The coupling means or welds of the prior art platen pouches so maintain the outer sheets that the insert card, upon abutment to the welds, is gripped between the outer sheets.

There was a substantial amount of testimony by those who actually used precut platen half pouches. The envelopes were often used in precisely the same manner as that claimed by the '512 patent. An insert card was inserted into the envelope or precut pouch (formed by joining two rectangular sheets by heat welds along one side), abutted against the coupling means or welds, gripped between the opposite sheets, and heat laminated. Subsequent to lamination, the envelope was often, but not always, trimmed or die-cut.

The second significant item of the prior art is the Dunn patent, the application for which was filed on April 20, 1966, prior to the alleged date of "invention" of the '512 patent. Dunn discloses an envelope (termed a "laminating unit") for use in laminating inserts and specifically describes the alignment or registration function provided by a coupling means. Also, like the '512 patent, the Dunn envelope was hinged along one of four edges, to provide a butterfly.

Moreover, Dunn teaches precutting, depicting a precut envelope of congruent sheets in the drawing and stating that the "laminating unit" may be made in an unlimited number of sizes or made in basic sizes to fit inserts of particular sizes.

The Dunn patent claims a pressure-sensitive adhesive method of lamination and refers to the well-known prior art use of machine lamination involving heat.

Avant, in an attempt to distinguish its '512 patent from the precut platen pouches and the Dunn patent argued the supposed arcane relationship of oozing of adhesive and congruency of the '512 patent envelope as a basis for finding invention in the '512 patent. Thus, Avant contended in the Court of Appeals that a congruent envelope embodied significant inventive creation which achieved necessarily remarkable results of lamination,

and Avant then attempted to read these unsupported and undisclosed advantages into the '512 patent. Similarly, Avant in its Petition before this Court raises numerous questions which focus upon congruency and oozing and attacks the findings of fact below because the District Court and the Court of Appeals could not find evidence which supported Avant's contentions.

Avant's attack on the treatment of congruency is raised in its Question 2 as a straw man for the proposition that the Court of Appeals opinion requires a patent to specify engineering detail. That straw man is created because the Court of Appeals could not find that congruency was the key to the asserted invention, that congruency eliminated oozing or that congruency transformed the patent to one which claims a technique for eliminating ooze. Avant asserted, as here (Petition p. 18), that the '512 patent achieved: "Trimming first, and then heat lamination afterwards." The Court of Appeals, like the District Court, id. at 905 (45a), found as a matter of fact that the patent did not achieve that result and that the patent failed to disclose those other factors which were necessary to achieve that result. 572 F.2d at 891 (53a).

In its Question 3, Avant asserts that the Court of Appeals mandates that a patentee meet the "intolerable burden" of proving "the subjective states of mind of persons skilled in the art" (Petition p. 16). This assertion is prompted because the Court of Appeals, in examining whether the word "congruent" transforms the entire

nature of the patent, noted the obvious proposition that if one wants even edges, one might logically start with even edges, id. at 891 (52a, 53a), an unimpeachable proposition established in the record, practiced in the past, and fully in accord with common experience and straightforward logic.

In Question 5 Avant again attacks, in terms of "synergy," the Court of Appeal's failure to find the "surprising result" of "congruency," challenging the concurrent findings of fact below that there was no evidence that congruency eliminated excessive "ooze." 441 F. Supp. at 905 (45a), 572 F.2d at 891 (53a).

In Question 7 Avant again invokes congruency, asserting that the '512 patent was commercially successful because the congruent envelope eliminated post-lamination trimming, an assertion without factual support. In this connection, Avant also attacks the fact finding of the courts below concerning improvements in the laminating art and their relationship to congruency. Yet at trial, there was substantial evidence of numerous such improvements which minimized oozing and had nothing to do with congruency, particularly improvements with respect to the type of plastic materials and amount of adhesive. Avant's own '514 patent evidenced such a refinement and claimed, as a means of eliminating ooze, sparse amounts of adhesive. None of those factors or improvements was claimed or taught by the '512 patent in issue.

The congruency controversy evidences the creative energies expended, not in the invention of a patentable process, but in endeavoring to save an invalid patent by redefining its claims and creating an aura of mystery and complexity concerning its scope. Avant asserts that the '512 patent claims a technique for eliminating post-lamination die-cutting achieved because congruent edges eliminate ooze of adhesive. In mundane terms, Avant is asserting that melting cheese will not flow out from between two pieces of bread if the edges of the bread are aligned.*

Avant's attacks on the findings below raise no questions which merit review by this Court. Those findings should not be set aside unless they are clearly erroneous, Fed. R. Civ. P. 52(a), particularly where, as here, the District Court and Court of Appeals concurred in those findings. This Court's function in reviewing concurrent findings was epitomized in Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271, 275 (1949) ("Graver I"): "A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error." [Citations omitted]. See also Alabama Power Co. v.

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* Making a grilled cheese sandwich with a spatula and a stove is one of many types of heat lamination -- bonding material under heat and pressure.

Ickes, 302 U.S. 464, 477 (1938); United States v. O'Donnell, 303 U.S. 501, 508 (1938). Concurrent findings of fact are particularly entitled to respect in a patent action, Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 610 (1950) ("Graver II"), and no less so in instances where the courts have invalidated the patent. Graver I, 336 U.S. at 279. In instances involving, as here, expert testimony, evaluation of prior art and demonstrations of the asserted capabilities of the patent, this Court has stated: "It is not for this Court to even essay an independent evaluation of this evidence. This is the function of the trial court." Graver II, 339 U.S. at 611. See also Williams Manufacturing Co. v. United Shoe Machinery Corp., 316 U.S. 364, 367 (1942) (findings of fact concerning whether a patent is a combination of old elements not to be disturbed where supporting evidence exists).

The District Court and Court of Appeals properly rejected Avant's assertions. In doing so, the courts below were supported by the evidence. Furthermore, they indulged Avant's theories and analyzed them with care. The courts below considered congruency from every possible perspective and found no view of congruency and oozing which could justify a monopoly of the laminating process embodied in the '512 patent or urged by Avant in its redefinition of its patent. First, both courts below found that congruent envelopes were known and used in the prior art. 572 F.2d at 890 (51a), 441 F. Supp. at 904 (41a-42a). Second,

both courts below held, consistent with Graver I, 336 U.S. at 277, that the '512 patent's scope was determined by its claims. 572 F.2d at 891 (54a), 441 F. Supp. at 900 (30a). The courts found that a fair reading of the claims and analysis of the evidence did not support reading the '512 patent as a patent for eliminating oozing, or a teaching to cut first and laminate second. 572 F.2d at 890-91 (52a, 54a), 441 F. Supp. at 905 (45a). Third, the Court of Appeals noted that if the patent were viewed as a process for eliminating oozing, it would necessarily be invalidated for failing distinctly to claim or adequately to describe its subject matter, pointing out that the patent did not reveal the steps of such a process nor refer to the numerous factors essential in eliminating ooze. 572 F.2d at 891 (53a-54a); cf. Graver I, 336 U.S. at 277-78 (process claims invalid for failing specifically to refer to essential constituents of composition used in the process). Fourth, the District Court noted that if the patent were indeed a technique for eliminating post-lamination die-cutting, that technique was known and used in the prior art, 441 F. Supp. at 905 (45a), a finding of fact fully supported by the evidence and not clearly erroneous. Fifth, the courts below observed that the notion that evenly aligned edges before heating facilitate evenly aligned edges after heating is obvious, and the Court of Appeals noted that no one would have thought otherwise, 572 F.2d at 891 (53a).

Beyond attacking the foregoing findings respecting the patent, Avant also urges, equally without merit, that the courts below did not analyze the '512 patent as a process patent (Question 4), that secondary indicia of non-obviousness were ignored by the courts (Question 6), and that the courts were so intellectually handicapped that they failed to grasp the issues of the case (Question 8).

The evidence and a fair reading of the decisions below are to the contrary. The courts below recognized that the '512 patent described and claimed a process or method and discussed the patent in those terms. 441 F. Supp. at 899 (29a); id. at 900 (30a); id. at 903-04 (41a); id. at 905 (45a); 572 F.2d at 890 (50a); id. at 891 (54a). However, they also recognized that the '512 process comprised providing an envelope and using that envelope in the normal manner suggested by its features.

A combination of old elements, whether embodied in a machine or a process, may not be patented if the combination does not produce a synergistic result. Sakraida v. Ag Pro, Inc., 425 U.S. 273, 282 (1976); Reckendorfer v. Faber, 92 U.S. 347, 356-57 (1875); Proler Steel Corp. v. Luria Brothers & Co., 417 F.2d 272, 277 (9th Cir. 1969); Accord, Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 60-61 (1969); Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152-53 (1950).

The courts below applied these tests, found that the aggregation of old elements achieved by the '512 patent was neither surprising nor synergistic and concluded that the '512 patent was obvious.

Avant's tenuous assertions of secondary indicia of non-obviousness (Question 6) are equally unavailing, especially when obviousness is so clearly established. There was insufficient evidence in the record of any sign-posts of non-obviousness. The courts below found no such signposts except to the extent they found the '512 patent "simple," a characteristic hardly probative of invention, and found that the envelope of the '512 patent was used as a part of a system which enjoyed commercial success, although there was no evidence to support a finding that that success was attributable to the patent, 572 F.2d at 892 (54a).

In any event, it is clear that the courts below followed the standards of this Court in assessing such argued signposts or secondary considerations of invention. "[C]ommercial success without invention will not make patentability." Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 153 (1950). That secondary considerations cannot salvage the obvious subject matter of a patent is manifest. In Graham v. John Deere Co., 383 U.S. at 17, this Court set forth the primary conditions that must be satisfied in any evaluation of obviousness and noted that such considerations as commercial success and failure of others are "secondary" considerations. The court made it clear, however, that those secondary considerations are no more than aids in the determination of obviousness, and that they do not supplant the primary tests or alter the statutory requirements.

There is no question that the courts below understood the patent and followed the directions of this Court in finding the '512 patent obvious. That the Court of Appeals used the terms "molding" and "laminating" interchangeably as a semantic convenience is not even suggested to affect analytically consideration of the '512 patent. Neither did the courts below misdirect their view of the prior art by looking at a prior art patent which used pressure rather than heat lamination. The pertinent features of the Dunn patent related to the structure of its congruent envelope and the courts found that it did not anticipate the '512 patent, but underscored the obviousness of the '512 patent.

POINT II

THE PROCEDURES FOLLOWED BY THE DISTRICT COURT CONFORM IN ALL RESPECTS WITH DUE PROCESS AND WITH BINDING PRECEDENT, AND PRESENT NO SUBSTANTIAL GROUNDS FOR THE GRANTING OF A WRIT OF CERTIORARI.

Avant raises a number of supposed procedural failings of the District Court as grounds for the issuance of a Writ of Certiorari. Upon examination, those supposed failings prove to be of the most trivial variety. Indeed, the trivial nature of most of the asserted procedural errors was conceded by Avant when it failed either to make objection in the District Court or to raise those

issues in the Court of Appeals. In any event, it is clear that the District Court's actions and rulings were wholly proper and fully in accord with binding precedent. Certainly, none of the procedural issues raised by Avant remotely approaches the standard for granting a Writ of Certiorari.

The procedural matters raised by Avant in its Petition include the following: (i) a delay of one year between trial and the rendering of a decision; (ii) the absence of certain portions of the record from the District Court files on certain dates; (iii) the utterance of a supposedly prejudicial remark; (iv) the shortness of the trial, supposedly depriving Avant of the ability to introduce certain evidence; (v) the reliance by the courts below on a prior art patent whose issuance was pending at the time the patent in suit issued; and (vi) the failure of the courts below to consider certain Rule 36 materials never offered in evidence by Avant.

Of those six procedural issues, numbers (i), (iii) and (iv) are raised for the first time in this Court. At no point below, either in the District Court or the Court of Appeals, did Avant assert as grounds for reversal that it was prejudiced by the delay between trial and decision, or object to the delay. With regard to the supposedly prejudical comment of the District Court, Avant's counsel failed to object to it in any way at trial, and failed to raise it as an issue before the Court of Appeals. Avant similarly utterly failed, until service of

the instant Petition, to object to the length of the trial, or to set forth any evidence which it might have been precluded from submitting by time pressure.

That a party has failed, despite many opportunities, to raise an issue below is grounds alone for this Court's refusing to consider it. As this Court recently stated in Regents of the University of California v. Bakke, 46 U.S.L.W. 4896, 4900 (June 28, 1978): "[T]his Court has been hesitant to review questions not addressed below." Accord, McGoldrick v. Compagnie Generale Transatlantique, 309 U.S. 430, 434-35 (1940); Blair v. Oesterlein Machine Co., 275 U.S. 220, 225 (1927) ("It is only in exceptional cases ... that questions not pressed or passed upon below are considered here.")

More important, Avant's failure to raise those issues previously, combined with the other relevant circumstances surrounding them, clearly shows their total lack of significance, even to Avant itself. Thus, although Avant now claims it was prejudiced because the trial lasted "only" two days, Avant rested its case, subject to the introduction of certain documentary exhibits, at the end of the first day. At the end of the second day the District Court once again asked Avant's counsel, George Kersey, if he had any further evidence to present, and he responded that he did not:

> THE COURT: ... Does the plaintiff have any further rebuttal?
>
> MR. KERSEY: No, Your Honor.

THE COURT: Both parties then rest?

. . .

MR. KERSEY: Yes, Your Honor.

(Trial Transcript, Second Day, p. 182.) Although Avant now claims that but for the supposedly shortened length of the trial it would have called Mr. Dunn as a witness (Petition at 24), Avant gave no indication at trial of any intention to call Mr. Dunn. Furthermore, on April 23, 1976, Avant submitted its "Memorandum Pursuant to March 29, 1976 Order" wherein it designated those witnesses whom it intended to call at trial. Mr. Dunn was not listed. The issue at this point is a pure afterthought, and certainly does not present the exceptional circumstances required to warrant this Court's consideration.

Examination of the remaining procedural issues similarly reveals both that the District Court's acts and rulings were wholly correct and that the issues raised are devoid of significance. Avant asserts that certain portions of the record were absent from the court files on certain dates, but shows no way in which it might have been harmed thereby. No assertion can be made that the District Court did not in fact review those portions of the record, and in any event the District Court attended the trial and took extensive notes of the proceedings. Furthermore, the questioned portions of the record were before the Court of Appeals, which affirmed the District Court's holding of invalidity. Although

Avant claims that the few "missing" items were the portions of the record "most favorable" to it (Petition at 10), in fact Avant designated only 18 transcript pages from those portions for inclusion in the Appendix on appeal to the Court of Appeals (Designation of Parts of the Record Which Appellant Intends to Include in the Appendix to Brief, dated August 15, 1977), while Polaroid designated 23 such transcript pages (Appellee's Designation of the Parts of the Record Which It Deems Should be Included in the Appendix, dated August 29, 1977).

The holdings of the courts below that the Dunn patent was part of the relevant prior art, even though the Dunn patent application was not public information at the time of issuance of the patent in suit, was correct. This Court dealt with the precise question in Hazeltine Research, Inc. v. Brenner, 382 U.S. 252 (1965), where it held that a co-pending patent application must be considered a part of the prior art even though its disclosures were secret and not known to the public. That decision has been uniformly followed by the federal courts, e.g., Shanklin Corp. v. Springfield Photo Mount Co., 521 F.2d 609, 617 (1st Cir. 1975), cert. denied, 424 U.S. 914 (1976); Triax Co. v. Hartman Metal Fabricators, Inc., 479 F.2d 951, 954 (2d Cir.), cert. denied, 414 U.S. 1113 (1973); In re Bass, 474 F.2d 1276, 1285 (C.C.P.A. 1973); Armour & Co. v. Swift & Co., 466 F.2d 767 (7th

Cir. 1972), and is soundly based in policy. As this Court stated in Hazeltine, supra:

> To adopt the result contended for by petitioners would create an area where patents are awarded for unpatentable advances in the art. We see no reason to read into §103 a restricted definition of 'prior art' which would lower standards of patentability to such an extent that there might exist two patents where the Congress has plainly directed that there should only be one.

382 U.S. at 256. Such a situation would hardly be consistent with the promotion of science and the useful arts mandated by the Constitution. In short, the Hazeltine rule is a clear and well-settled principle of patent law. The following of that principle by the courts below cannot warrant issuance of a Writ of Certiorari. See Rule 19(1)(b), Rules of the Supreme Court of the United States.

The exclusion by the courts below of certain Rule 36 materials once again was both a correct ruling and wholly devoid of significance worthy of the attention of this Court. Indeed, Avant concedes that the ruling was at worst "harmless error." (Petition at 27.) Avant also concedes that it rested its case without offering the Rule 36 admissions or reserving a right to designate them; nor did Avant move for a new trial upon learning of the preclusion. This Court should also be informed that many of the Rule 36 materials in question were served on Polaroid on the eve of trial,

so that responses were not due under the Rule until after the date of trial, and Polaroid never responded to those requests. As the District Court commented in its decision: "Polaroid raises serious questions as to whether ... all the requests for admissions could be deemed admitted under the given circumstances." 441 F. Supp. at 900 n.2 (32a).

CONCLUSION

For all the reasons stated above, Polaroid respectfully requests that the Petition for a Writ of Certiorari be denied in all respects.

Respectfully submitted,

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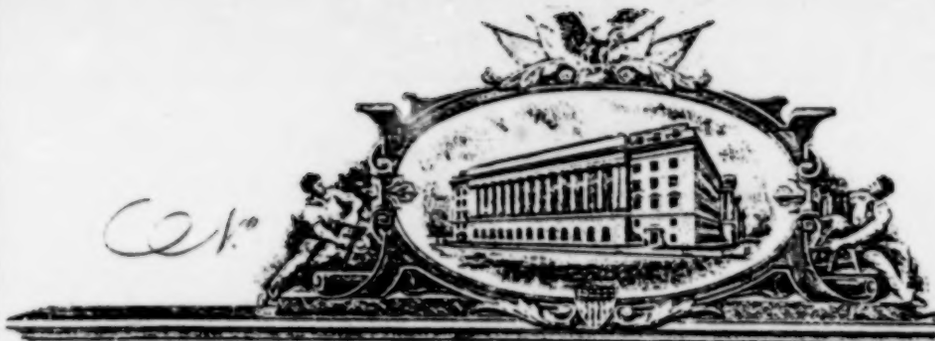
APPENDIX



3679512

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

Whereas, THERE HAS BEEN PRESENTED TO THE

Commissioner of Patents

A PETITION PRAYING FOR THE GRANT OF LETTERS PATENT FOR AN ALLEGED NEW AND USEFUL INVENTION THE TITLE AND DESCRIPTION OF WHICH ARE CONTAINED IN THE SPECIFICATION OF WHICH A COPY IS HEREUNTO ANNEXED AND MADE A PART HEREOF, AND THE VARIOUS REQUIREMENTS OF LAW IN SUCH CASES MADE AND PROVIDED HAVE BEEN COMPLIED WITH, AND THE TITLE THERETO IS, FROM THE RECORDS OF THE PATENT OFFICE IN THE CLAIMANT(S) INDICATED IN THE SAID COPY, AND WHEREAS, UPON DUE EXAMINATION MADE, THE SAID CLAIMANT(S) IS(ARE) ADJUDGED TO BE ENTITLED TO A PATENT UNDER THE LAW.

NOW, THEREFORE, THESE **Letters Patent** ARE TO GRANT UNTO THE SAID CLAIMANT(S) AND THE SUCCESSORS, HEIRS OR ASSIGNS OF THE SAID CLAIMANT(S) FOR THE TERM OF SEVENTEEN YEARS FROM THE DATE OF THIS GRANT, SUBJECT TO THE PAYMENT OF ISSUE FEES AS PROVIDED BY LAW, THE RIGHT TO EXCLUDE OTHERS FROM MAKING, USING OR SELLING THE SAID INVENTION THROUGHOUT THE UNITED STATES.

In testimony whereof I have hereunto set my hand, and caused the seal of the Patent Office to be affixed at the City of Washington this twenty-fifth day of July, in the year of our Lord, one thousand nine hundred and seventy-two, and of the Independence of the United States of America the one hundred and ninety-seventh.

Attest:

Mary M. Gibson Jr.

Attesting Officer.

28r

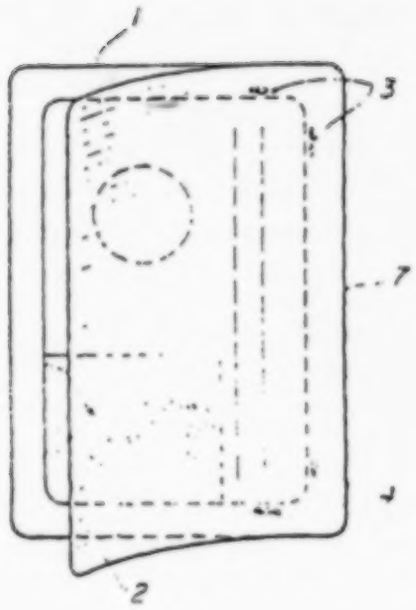
Commissioner of Patents.

(PART I)

July 25, 1972 F. W MACONE 3,679,512

LAMINATED CARD ENVELOPE

Original Filed April 19, 1967



FREDERICK W. MACONE
INVENTOR

By Robert J. Mattern
ATTORNEY

United States Patent Office 3,679,512
Patented July 25, 1972

3,679,512
LAMINATED CARD ENVELOPE

Frederick W. Macone, Carlisle, Mass., assignor to Avant Corporation, Lincoln, Mass.

Original application Apr. 19, 1967, Ser. No. 632,072, now Patent No. 3,526,567.
Divided and this application May 20, 1970, Ser. No. 39,035
Int. Cl. B32b *31/20*; G09f *3/02*
U.S. Cl. 156—272 2 Claims

ABSTRACT OF THE DISCLOSURE

This disclosure illustrates a novel envelope for receiving and properly orienting a data card positioned within the envelope which is thereafter subjected to heat and pressure to produce a composite, multilayered laminated card.

The present invention relates to a laminated card envelope for facilitating the manufacture of laminated cards.

CROSS REFERENCE TO RELATED APPLICATION

This application is a division of application Ser. No. 632,072, now Pat. No. 3,526,567, filed Apr. 19, 1967, assigned to the same assignee as the present invention.

BACKGROUND OF THE INVENTION

Laminated cards containing printed or pictorial data cards are usually produced by manually orienting the data card with respect to the inside faces of the larger outer plastic sheets which "sandwich" the data card. Generally it is desirable to manipulate the data card so that its edges are parallel to the edges of the outer plastic sheets and so that the border surrounding the data card is even or symmetrical. Often, before the composite card, bearing the centered data card, is exposed to heat and laminating pressure in the laminator the inner data card changes position to produce an unsightly card or even a ruined one where the data card extends beyond the edges of the outer plastic sheets. Additionally, a given pre-determined position of the inner card with respect to the outer plastic sheets is required if the laminated card is to be embossed or coded for automatic data processing reading equipment. The positioning of the inner data card is sometimes further impeded by a moist card (e.g., a photographic print not fully dried) sticking to the inside faces of the outer plastic cards. The envelope of the present invention is constituted so that a moist photographic print may be rapidly inserted and properly oriented without rubbing or being pressed against the inner faces of the plastic sheets which causes abrasion and consequent damaging of the moist emulsion surface. In any event, it is highly desirable, especially for rapid production, to provide means for rapidly and accurately positioning the inner data card with respect to the outer plastic cards in a manner which impedes shifting of the inner card before lamination.

SUMMARY OF THE INVENTION

In accordance with a preferred embodiment of the invention, first and second outer plastic sheets are heat sealed or spot welded to produce a pair of nests each consisting of orthogonally positioned elongated welds, separated by an amount substantially equal to a major dimension (length or width) of the inner data card. The welds or seals couple and maintain the outer sheets in a congruent relationship, while they act as nests to receive and properly orient the inner data card which may be inserted in a second or so. Since the nests lie just outside of the corner edges of the cards, they prevent a shift in card position before lamination.

SPECIFIC DESCRIPTION

The figure illustrates outer plastic cards 1 and 2, sealed or welded together by nests 3 and 4 each consisting of elongated, orthogonally positioned seals or welds. "L" shaped electrodes may be applied

to the congruent cards to heat seal or weld them as shown. The nests are preferably positioned just beyond the corner edges of the inner inserted data card 6 so as to "frame" the card and prevent the aforesaid shifting. The elongated welds or seals making up each nest need not actually intersect, and for that matter need not necessarily be elongated. The outer sheets may be completely separate before being coupled together by the seals or could be formed of a single double sized sheet of plastic folded along edge 7.

The folding of a double sized plastic sheet before insertion of the data card and lamination, with or without the aforesaid nests, is particularly suitable for very high mass production where the outer sheets need not be of different material. In the absence of nests and for certain applications, the fold itself acts to maintain the outer sheets in the proper relationship and may be used to orient the data card where a major dimension of the card, such as its length or width, is positioned against the fold. Also, this approach may be utilized in conjunction with a single spot weld or heat seal. In other words, the length of the card, for example, may be positioned against the fold and its width may be positioned against a single elongated or spot weld.

Obviously, many modifications and variations of the present invention are possible in the light of the above teachings. It is therefore to be understood, that within the scope of the appended claims, the invention may be practiced otherwise than as specifically described.

I claim:

1. A method of producing a laminated data card having a plurality of edges comprising the steps of:

(A) providing an envelope having:

(1) coupling means positioned between the inner heat activatable adhesive-bearing surfaces of a pair of outer sheets to be laminated together for maintaining said outer sheets in a congruent face-to-face relationship with each other;

(2) said coupling means being positioned with respect to said pair of outer sheets for permitting wide separation of major portions of the outer coupled sheets;

(3) said coupling means being positioned with respect to the edges of said pair of outer sheets for properly locating an edge of an inner data-bearing sheet inserted between said coupled outer sheets and abutting said coupling means;

(B) separating said other sheets along at least two adjacent edges to permit an inner data-bearing sheet to be easily and rapidly inserted between said outer sheets and gripped thereby;

(C) inserting an inner data-bearing sheet between said outer sheets and against said coupling means for accurately positioning an edge of said data-bearing sheet with respect to said outer sheets; and

(D) laminating said outer sheets and said inner data-bearing sheet together by the application of heat thereto.

2. The method of claim 1 wherein said coupling means is formed by heat sealing said first and second outer sheets together at widely separated portions of said outer sheets to provide for accurate alignment of the edges of said inner data bearing sheet with respect to the coupled outer sheets.

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U.S. Cl. X.R.

40—1.5, 2.2; 156—290, 293, 306; 283—7